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| 10/705,768 | 11/10/2003 | Matt Clark | 109927-135181 | 4373 |
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| SCHWABE, WILLIAMSON & WYATT, P.C. PACWEST CENTER, SUITE 1900 1211 SW FIFTH AVENUE PORTLAND, OR 97204 | | | | |
| | | | EXAMINER LOVEL, KIMBERLY M | |
| | | | ART UNIT 2167 | PAPER NUMBER |

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/705,768

Applicant(s)

CLARK ET AL.

Examiner

Kimberly Lovel

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is responsive to the Amendment filed 30 May 2006.
2. Claims 1, 4-15 are pending in this application. Claim 1 independent. In the Amendment filed 30 May 2006, claims 2-3 have been cancelled and claims 1, 4-12 and 14-15 have been amended. This action is made Final.
3. The rejections of claims 1-6 and 9-15 as being anticipated by US PGPub 2002/0123359 to Wei et al and claims 7-8 as being unpatentable over Wei et al in view of US PGPub 2002/0107891 to Leamon et al have been withdrawn as necessitated by the amendment.

Drawings

4. The objections to the drawings have been withdrawn as necessitated by the amendment and applicants' arguments.

Claim Objections

5. The objection of claims 1 has been withdrawn as necessitated by the amendment.
6. Claim 4 is objected to because it is a depends on claim 3, which was cancelled. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PGPub 2002/0123359 to Wei et al (hereafter Wei et al) in view of US Patent No. 6,580,916 to Weisshaar et al (hereafter Weisshaar et al).

Referring to claim 1, Wei et al disclose a computer server implemented method of providing information to a client device (see [0032], lines 3-6 – the SMS server is connected to a mobile phone; the SMS server is considered to represent the *computer server*; the mobile phone is considered to represent a *client device*), the method comprising: receiving a request for a service (see [0032]-[0037]); directing said request to a remote service provider (see [0032], lines 3-6 – the internet is considered to represent a *remote service provider*); adapting any response to said request to the wireless mobile device utilizing a predetermined feature-based template having one or more HTML pages, text pages, images, buttons, actions, calendars, favorites and data structures (see [0037] and [0038]); and providing said adapted response to the wireless mobile device for depiction within a response adaptable environment (see [0038] and [0042]). However, Wei et al fail to explicitly disclose the further limitations of the actions being performed with regards to a framework server.

Weisshaar et al discloses a service framework (see abstract), including the further limitations of

receiving, by a framework system server [one of the servers shown by server 102], a request for a service from a client device [user device 108 comprising a client platform 200] expressed in terms of one or more concepts of one or more features of the service (column 2, lines 48-49 – user request service/information);

directing, by the framework system server [one of the servers shown by server 102], said request to a service providing server [one of the servers shown by server 102], the service providing server further directing the request for service to a plurality of vendors [local node 106], each of the plurality of vendors separate and distinct from each other and from the framework system server and the service providing server (see column 20, lines 20-44);

receiving, by the framework system server, a response to the request for service from the service providing server, the response including one or more solutions to the request provided by one or more of the plurality of vendors (see column 20, lines 40-44); and

providing said adapted response to the client device (see column 20, lines 40-44; Fig 8, column 20, line 55 – column 21, line 15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Weisshaar et al's concepts of a framework server with Wei et al's method for providing an adapted response to a request for a service. One would

have been motivated to do so in order to provide a wide variety of services to different types of clients.

Referring to claim 4, the combination of Wei et al and Weisshaar et al (hereafter Wei/Weisshaar) discloses the method of claim 3, wherein said adapted response further comprises at least two solutions to the request, and an index to the at least two solutions (Wei et al: see [0038], lines 1-7).

Referring to claim 5, Wei/Weisshaar et al discloses the method of claim 1, wherein said adapted response further comprises supplemental information related to said request (Wei et al: see [0070], lines 7-9 – member's names and age is considered to represent supplemental information since it is consolidated data).

Referring to claim 6, Wei/Weisshaar et al discloses the method of claim 5, wherein said supplemental information is delivered to the client device prior to the receipt by the client device of the one or more solutions (Wei et al: see [0071] – the sports club can create a query based on the consolidated data).

Referring to claim 9, Wei/Weisshaar et al discloses the method of claim 1, wherein adapting the response to said request comprises localizing the response for the client device, based at least on a type of the client device (Wei et al: see [0033]-[0034] – using the customer security number and the merchant UIN is considered to represent localizing the response since the response is for a particular customer).

Referring to claim 10, Wei/Weisshaar et al discloses the method of claim 5, wherein if the one or more solutions are provided to the client device before the

supplemental information is to be provided, then the supplemental information is not provided to the client device (Wei et al: see [0070], lines 1-7).

Referring to claim 11, Wei/Weisshaar et al discloses the method of claim 1, wherein said adapted response comprises a solution command selectable by a user of the client device (Wei et al: see [0093] – a user selects to purchase a PDA).

Referring to claim 12, Wei/Weisshaar discloses the method of claim 11, wherein said solution command, on selection, requests service from a vendor of the plurality of vendors other than another vendor who caused the solution command to be include as part of the adapted response (Wei et al: see [0093]-[0110] – when checking out, credit card information is validated by iPayment's server; iPayment is considered to represent a second vendor).

Referring to claim 13, Wei/Weisshaar discloses the method of claim 1, wherein the service is associated with a first feature, and said adapted response comprises updates to a data item of a database associated with a second feature (Wei et al: see [0079] – the first feature is considered to be represented by broadcasting target messages; the second feature is considered to be represented entering user profile information into the database).

Referring to claim 14, Wei/Weisshaar et al discloses a computer readable medium containing computer executable instructions for performing the actions of the method of any of claims 1,5,7,9-13 (Weisshaar et al: see column 7, lines 25-32 – a computer readable medium such as user node memory 128).

Referring to claim 15, Wei/Weisshaar discloses an apparatus having a processor and a memory coupled to the processor containing computer executable instructions operative to perform the actions of the method of any of claims 1,5,7,9-13 (Wei et al: see [0032] – the SMS server is considered to represent the *apparatus*).

9. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PGPub 2002/0123359 to Wei et al in view of US Patent No. 6,580,916 to Weisshaar et al as applied to claim 1 above, and further in view of the Background of the Invention of US PGPub 2002/0107891 to Leamon et al (hereafter Leamon et al).

Referring to claim 7, Wei et al teach a response to a request. However, Wei et al fail to explicitly teach the further limitation of the request wherein any response to said request is received in an XML format. Leamon et al teach a method of responding to a request including the further limitation of the request. In particular, Leamon et al teaches a method similar to that of claim 1, wherein the response received by the framework system server from the service providing server is received in an XML format (see [0006]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Leamon et al's method receiving responses to requests in the form of XML documents with Wei et al's method. One would have been motivated to do so since mobile phones communicate with WML (Wei et al: see [0003], lines 8-9).

Referring to claim 8, the combination of Wei et al and Leamon et al discloses the method of claim 7, wherein adapting the XML formatted response comprises

Art Unit: 2167

processing, by the framework system server, the response via an XSLT (Leamon et al: see [0006]).

Response to Arguments

10. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Miscellaneous

11. Page 9 of the Amendment states "Applicants respectfully direct the Examiner's attention to the fact that the primary inventor is Roundtree (not Clark), and request the record to be updated to reflect this fact."

605.04(f) [R-3] Signature on Joint Applications - Order of Names

The order of names of joint patentees in the heading of the patent is taken from the order in which the typewritten names appear in the original oath or declaration. Care should therefore be exercised in selecting the preferred order of the typewritten names of the joint inventors, before filing, as requests for subsequent shifting of the names would entail changing numerous records in the Office. Since the particular order in which the names appear is of no consequence insofar as the legal rights of the joint applicants are concerned, no changes will be made except when a petition under 37 CFR 1.182 is granted. The petition should be directed to the attention of the Office of Petitions. The petition to change the order of names must be signed by either the attorney or agent of record or all the applicants. Applicants are strongly encouraged to submit an application data sheet showing the new order of inventor names to ensure appropriate printing of the inventor names in any patent to issue. It is suggested that all typewritten and signed names appearing in the application papers should be in the same order as the typewritten names in the oath or declaration. When the Office of Petitions grants a petition to change the order of the names of the inventors, the Office of Petitions will change the order of the names in the Office computer records and print a new bib-data sheet, unless the application is an 08/ or earlier series application, in which case, the application should be sent to the Office of Initial Patent Examination (OIPE) for correction on the file wrapper label and the PALM database. >Since a change to the order of

Art Unit: 2167

the inventor's names is an amendment to the application and amendments are not permitted after the payment of the issue fee (37 CFR 1.312), a petition under 37 CFR 1.182 to change the order of the inventor's name cannot be granted if filed after the payment of the issue fee.< In those instances where the joint applicants file separate oaths or declarations, the order of names is taken from the order in which the several oaths or declarations appear in the application papers unless a different order is requested at the time of filing.

Therefore, a petition under 37 CFR 1.182 needs to be filed by the applicants in order to change the primary inventor to Roundtree (not Clark).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US PGPub 2002/0103720 to Cline et al titled "Extensible Network Services System" which focuses on the use of XML

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Lovel whose telephone number is (571) 272-2750. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimberly Lovel
Examiner
Art Unit 2167

kml
11 Aug 2006


JOHN COTTINGHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

 18 August 2006